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09/732,352	12/07/2000	Paul E. Jacobs	PA000397	1684

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Qualcomm Incorporated  
Patents Department  
5775 Morehouse Drive  
San Diego, CA 92121-1714

EXAMINER

ALVAREZ, RAQUEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/732,352

Applicant(s)

JACOBS ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,19-27,31,32,65,93-101,126,130-133,135-143 and 169-174 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,19-27,31,32,65,93-101,126,130-133,135-143 and 169-174 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/13/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office action is in response to communication filed on 6/30/2004.
2. Claims 1, 3-7, 19-27, 31, 32, 65, 93-101, 126, 130-133, 135-143 and 169-174 are presented for examination.

### **Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 3-7, 19-23, 24-28, 31, 32, 65, 93-101, 126, 130-133, 135-143 and 169-174 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40, 111-113, 126-127, 136-137 and 146 of copending Application No.09/679,039. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites transmitting ad-statistical data. Calculating and transmitting statistical data it is old and well known in business in order to calculate and transmit statistical data in order to make educated assumptions and statements on a particular

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subject. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting ad-statistical data in order to achieve the above mentioned advantage.

4. Claims 1, 3-7, 19-23, 24-28, 31, 32, 65, 93-101, 126, 130-133, 135-143 and 169-174 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No.09/679,038. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application further recites an ad link history display window that lists links to the sources of advertisements that the user has previously visited. Listing the sources of advertisements or information that the user has previously visited it is old and well known in order to keep track of the success of the different sources of advertisements. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have included a display window that lists links to the sources of advertisements that the user has previously visited in order to achieve the above mentioned advantage.

5. Claims 1, 3-7, 19-23, 24-28, 31, 32, 65, 93-101, 126, 130-133, 135-143 and 169-174 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-51 of copending Application No.09/728,693. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application further recites that the advertisement download communication link and the data communication link are separate communication links. It is old and well known in the

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communication and networking arts to have various communication links because such a modification would allow for easier transmission of data. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have link are separate communication links in order to achieve the above mentioned advantage.

6. Claims 1, 3-7, 19-23, 24-28, 31, 32, 65, 93-101, 126, 130-133, 135-143 and 169-174 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 and 51-53 of copending Application No.09/668,553. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites transmitting ad obscured ad monitor function that determines whether an obscured ad condition has occurred, whereby the obscured ad condition occurs when an advertisement current being displayed on the display associated with the client device is being obscured by one or more other items currently being displayed on the display and an obscured nag function that generates an obscured ad nag display in response to detection of the obscured ad condition, wherein the obscured nag display notifies the user of the obscured ad condition. Since, monitoring and displaying various advertisements which can occupy the entire portion of the display along with banner advertisements is obvious in on-line advertisements then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included detecting if a displayed advertisement such as a banner advertisements is being obscured by an advertisement and notifying the user in order for the user to be aware

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that might not be compensated for viewing the banner advertisements that is being obscured by the advertisement.

7. Claims 1, 3-7, 19-23, 24-28, 31, 32, 65, 93-101, 126, 130-133, 135-143 and 169-174 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-33, 59 and 62 of copending Application No.09/668,331. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites a playlist that identifies the advertisements to be downloaded. Identifying or selecting the advertisements to be downloaded is obvious and well known in order to provide some sort of order within the system. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting ad-statistical data in order to achieve the above mentioned advantage.

8. Claims 1, 3-7, 19-23, 24-28, 31, 32, 65, 93-101, 126, 130-133, 135-143 and 169-174 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 46-70 and 74-76 of copending Application No.09/668,632. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites an e-mail function for receiving and sending e-mail to other client devices. Sending and receiving e-mail to other clients is old and well known in the computer related arts in order to receive messages immediately from other clients. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving and

sending e-mail messages in order to achieve the above mentioned advantage.

9. Claims 1, 3-7, 19-23, 24-28, 31, 32, 65, 93-101, 126, 130-133, 135-143 and 169-174 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36-70, 74-76 and 78 of copending Application No.09/668,515. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application further recites three operating modes. Different operating modes such as Online and offline operating modes are known in the computer related arts in order to provide different states of the program. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving and sending e-mail messages in order to achieve the above mentioned advantage.

10. Claims 1, 3-7, 19-23, 24-28, 31, 32, 65, 93-101, 126, 130-133, 135-143 and 169-174 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,9-11,14-24,43,45-54,77-79,81,82,84,86-92,94,95,97-105,107-109 and 111 of copending Application No.09/668,631. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites a playlist that identifies the advertisements to be downloaded. Identifying or selecting the advertisements to be downloaded is obvious and well known in order to provide some sort of order within the system. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting ad-statistical data in order to achieve the above mentioned advantage.

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11. Claims 1, 3-7, 19-23, 24-28, 31, 32, 65, 93-101, 126, 130-133, 135-143 and 169-174 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-53 of copending Application No.09/668,600. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application further recites a third operating mode in which the software switches the operating from a first operating mode to a second operating mode, wherein the second operating mode has less features than the first operating mode. Official notice is taken that it is old and well known in the computer related arts to switch from one operating mode to another operating mode that has less features when a problem arises with one of the operating mode because such a modification would allow the software to operate with less features and in that case less problems are less likely to occur. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included switching from a first operating mode to a second operating mode, wherein the second operating mode has less features than the first operating mode in order to obtain the above mentioned advantage.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.



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12. Claims 1, 3-7, 19-20, 24-25 and 93-98 are rejected under 35 U.S.C. 102(b) as being anticipated by Marsh et al. (5,848,397 hereinafter Marsh).

With respect to claims 1, 24 and 25, Marsh teaches a playlist server system for supplying a playlist response to a client device exchanging information with an information server system over a communications network (abstract). Playlist response generating means for generating a playlist response identifying a plurality of selected ads to be presented by the client device (Figure 8 and col. 15, lines 1-10); first communications means for establishing a playlist response send communications link with the client device via the communications network over which the playlist response is transmitted to the client device (col. 15, lines 1-10); wherein the information server system and the playlist server are independently controlled (col. 13, lines 56 to col. 14, lines 1-63).

With respect to claims 3-7, 19, 20, 93-98 Marsh teaches that a playlist function merges the current playlist and the current new playlist (col. 15, lines 2-13).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 21- 23, 26-28, 31, 32, 65, 93-101, 126, 130-133, 135-143 and 169-174 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh.

Claim 21-23, 99-101 further recites deleting from storage advertisements that are not including in the playlist. Official notice is taken that it is old and well known to delete from a database information that are not going to be needed in order to free the database of unnecessary information. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included deleting from storage advertisements that are not including in the playlist in order to obtain the above mentioned advantage.

With respect to claims 26-32, the claim further recites parsing means for extracting selected information from the playlist list. Official notice is taken that it is old and well known in the computer related arts to parse and extract selected information in order to enable only relevant information to be remained. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included parsing means for extracting selected information from the playlist list in order to achieve the above mentioned advantage.

With respect to claims 65, 126, 130, 131 and 135, in addition to the limitations previously addressed above, the claims further recite a extensive markup language for verifying the wellformedness of the playlist request. Official notice is taken that it is old and well known in the computer related arts to have an extensive markup language (XML) format which renders the data accessible to a wide variety of clients and applications. It would have been obvious to a person of ordinary skill in the art at the time to have included extensive markup language for verifying the wellformedness of the playlist request because such a modification would render the playlist request

accessible to a variety of clients and applications.

With respect to claims 132-133, 136, Marsh further teaches a user activity monitor function that monitors user activity such as used over a prescribed time period(col. 15, lines 14-18).

With respect to claim 137, Marsh further teaches that the new playlist is customized/tailored to the user/client device (col. 15, lines 31-53).

With respect to claims 138-143, the claims further recite specifying the total display time that the ads are to be displayed by the client device during the present day. Since in Marsh the scheduler 700 arranges the sequence and order of the ads and determines if the ads have been viewed then it would have been obvious in the Marsh system to specify the total times that the ads have to be viewed during that particular day in order to determine if the client complied on that day with the amount of ads that he or she is supposed to view.

With respect to claims 169-171, Marsh teaches that a playlist function merges the current playlist and the current new playlist (col. 15, lines 2-13).

Claims 172-174 further recites deleting from storage advertisements that are not including in the playlist. Official notice is taken that it is old and well known to delete from a database information that are not going to be needed in order to free the database of unnecessary information. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included deleting from storage advertisements that are not including in the playlist in order to obtain the above mentioned advantage.

**Response to Arguments**

14. The Double patenting rejections are sustained. Applicant is reserving response to the provisional rejections until all other issues of patentability are settled in all applications. Therefore the double patenting rejections are sustained.

15. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a playlist response with a data structure with a client information section which updates general client behavior regarding ads, i.e. speed with which the ads turn over and a playlist which describes the ads the client should fetch) and (i.e., the playlist being a list of URNs from which to fetch the actual ads as well as a set of attribute-value pairs, on a per-ad basis) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

16. Applicant argues that Marsh doesn't teach a playlist server system that includes generating means for generating a playlist response identifying a plurality of selected ads to be presented by the client device. The Examiner respectfully disagrees with Applicant because Marsh teaches on col. 15, lines 53, "The advertisement distribution scheduler is located at the server system 104. The advertisement distribution scheduler generates an assignment of advertisements to users and their computers. For example, a particular advertisement for orange juice may be assigned by the

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advertisement distribution scheduler to all residents of New York City and all college students in Boston. Each advertisement has associated with it an ad contract which specifies a demographic profile reach and frequency, duration and time of expiry for the advertisement. The ad contract can be stored in the database management system 106. Using the information about each user received by the server system 104, the advertisement distribution scheduler assigns advertisements to users. In the representative embodiment, the advertisement distribution scheduler uses information received from the user via the member profile that is stored in the database management system 106 to allocated advertisements. Demographic information collected from other sources can also be used by the advertisement distribution scheduler. Thus, the advertisement distribution scheduler runs database selects on the user demographic information stored in the database management system 106 to produce a list of users for each advertisement”.

17. With respect to Applicant’s argument that Marsh doesn’t teach the information server system and the playlist server being independently controlled. Marsh teaches on Figure 8, 2 different servers 107 and 108 connected to server subsystem 104, a user using client computer 101 can access advertisement information from server 107 or 108.

18. Applicant argues that Marsh doesn’t teach a data communication link and an advertisement communication link being separate links. In Marsh, the user can access the e-mail without accessing the advertisements. The user makes a first

communication link to access the e-mail and then in order to access the advertisements, the user makes a second communication link by clicking on the advertisements, which is a separate link from the first communication link (col. 7, lines 57-65).

19. With respect to merging the current playlist with the new playlist, The Examiner wants to point out that Marsh teaches that the advertisement distribution scheduler maximizes potential revenues by aggregating or adding additional advertisements to the client's current playlist (col. 15, lines 54 to col. 16, lines 1-64).

20. With respect to deleting selected ads from the playlist when the client receives a new playlist. The Examiner wants to point out that since Marsh teaches maximizing revenues by adding or aggregating additional advertisements to the playlist (col. 15, lines 54 to col. 16, lines 1-64) then it would have been obvious and would have made sense to delete the old or unnecessary ads. In response to applicant's argument that the deletion of the ads is not to delete unneeded information from a database, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

21. With respect to the official notice taken. The Applicant is reminded that while applicant may challenge the examiner's use of Official Notice, applicant needs to

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provide a proper challenge that would at least cast reasonable doubt on the fact taken notice of. See MPEP 2144.03 where In re Boon is mentioned.

22. With respect to an event log that contains information about the various actions taken by the user at prescribed time interval. Marsh clearly teaches keeping track of the user's activity for billing information and to keep statistics on the user's information so therefore the time interval must likely is present in order to keep statistics of when the information is collected.

23. With respect to a new playlist is customized/tailored to the user/client device. Marsh clearly teaches on col. 15, lines 31-53, customizing the ads to be downloaded and presented based on the customer's profiles

24. With respect to specifying the daily quota of the ads are to be displayed by the client device during the present day. The Examiner wants to point out that Marsh further teaches on col. 3, lines 66 to col. 4, lines 1-6, the minimum and maximum exposure of the advertisements to the user in order to maximize the revenues arrangements with the vendors of the ads.

### ***Conclusion***

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Point of contact**

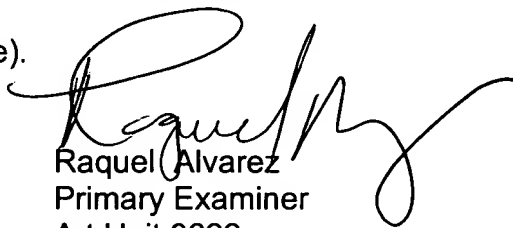
26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raquel Alvarez  
Primary Examiner  
Art Unit 3622

R.A.  
9/22/04